

### **REMARKS**

This Amendment is responsive to an Office Action in this case mailed on April 6, 2004. In the Office Action, the Examiner rejected claims 1-6 and 11-16 under 35 U.S.C. § 102(b) over U.S. Patent No. 6,663,585 to Ender (hereinafter "Ender"), and rejected claims 7-9 and 17-21 under 35 U.S.C. §103(a) over Ender. Applicants respectfully traverse these rejections.

Claims 1-21 are pending in this application. By this Amendment, claims 1-21 are cancelled without prejudice, and claims 22-48 are added to more appropriately claim the present invention. No new subject matter has been added.

New claim 22 recites, among other things, a method of monitoring a cardiovascular access during an extracorporeal blood treatment. The method includes a step of providing a conductive connection between the arterial branch and the venous branch. New claim 33 recites a device for monitoring a cardiovascular access during an extracorporeal blood treatment comprising a conductive connection arranged between a first passage point of an arterial branch and a second passage point of a venous branch of the extracorporeal blood circuit. Support for these limitations in claims 22 and 33 may be found, for example, in Figs. 1-3, illustrating conductive connectors 19, 20 (Figs. 1-2) or 23, 24 (Fig. 3) between the arterial branch and the venous branch. (See also, specification at page 8, lines 26-34).

Applicants respectfully traverse the Examiner's rejection of originally-filed claims 1-6 and 11-16 under 35 U.S.C. § 102(b) as being anticipated by Ender. In order to properly anticipate Applicants' claimed invention under 35 U.S.C. § 102, each and every

element of the claim in issue must be found, either expressly described or under principles of inherency, in a single prior art reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." See M.P.E.P. §2131 (8th ed., Aug. 2001), quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Finally, "[t]he elements must be arranged as required by the claim." M.P.E.P. § 2131 (8th ed., 2001), p. 2100-69. Applicants respectfully submit, however, that the Examiner's rejection is moot in light of Applicants' cancellation of claims 1-6 and 11-16.

Insofar as the Examiner's rejection under 35 U.S.C. § 102 is relevant to new claims 22-48, Applicants respectfully submit that new claim 22, for example, is not anticipated by Ender at least because the reference fails to teach each and every element of the claim. In particular, Ender fails to disclose at least the claimed method comprising the step of "providing a conductive connection between the arterial branch and the venous branch" of the "extracorporeal blood circuit," as recited in new claim 22.

The sole figure of Ender shows an arterial blood line 5 and a venous blood line 7. Ender, however, is entirely silent as to a conductive connection between these two blood lines, nor is any such connection shown in the Ender figure. Accordingly, Ender necessarily fails to teach the claimed method including a step of "providing a conductive connection between the arterial branch and the venous branch" of the "extracorporeal blood circuit," as recited in new claim 22.

New claim 33 recites "a conductive connection arranged between a first passage point of an arterial branch of an extracorporeal blood circuit, and a second passage

point of a venous branch of the extracorporeal blood circuit,” and is therefore similar to claim 22 in this respect. New claim 33, therefore, is allowable at least for reasons discussed above in regard to new claim 22.

In light of the above-described deficiencies of Ender, Applicants respectfully submit that added claims 22 and 33 are allowable over the applied reference. Moreover, claims 23-32 are allowable at least due to their dependence from allowable claim 22, and claims 34-48 are allowable at least due to their dependence from allowable claim 33.

Applicants respectfully traverse the Examiner's rejection of originally-filed claims 7-9 and 17-21 under 35 U.S.C. § 103(a) as unpatentable over Ender. To the extent the Examiner's rejection is understood, Applicants note that in order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, the prior art reference (or references when combined) must teach or suggest all the claim elements. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Third, there must be a reasonable expectation of success. See M.P.E.P. § 2143.

In rejecting originally-filed claims 7-9 and 17-21, the Examiner alleges that “Ender discloses the apparatus as claimed with the exception of the varied locations of the voltage inducer and detector.” The Examiner concludes, without citation to Ender or any other reference for that matter that, “it would have been obvious to one of ordinary skill in the art at the time of invention to move the coils into locations claimed by

Applicants since it has been held that rearranging parts of an invention involves only routine skill in the art."

Applicants respectfully submit that such unsupported assertions are insufficient to maintain the rejections to originally-filed claims 7-9 and 17-21 under 35 U.S.C.

§ 103(a). "The mere fact that [one of skill] in the art could rearrange the parts of the reference device to meet the terms of the claims...is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason...to make the necessary changes in the reference device." Ex parte Chicago Rawhide Mfg. Co., 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984).

In any event, even if Ender were modifiable in the manner proposed by the Examiner (and Applicants do not agree that it is), Applicants respectfully submit that, for reasons discussed above, the reference would still fail to teach each and every element of new claims 22 and 33. New claims 22 and 23 are therefore allowable over Ender for this reason also.

Further, as noted above, claims 23-32 are allowable at least due to their dependence from allowable claim 22, and claims 34-48 are allowable at least due to their dependence from allowable claim 33.

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

The Office Action contains characterizations of the claims and the related art, with which Applicants do not necessarily agree. Unless expressly noted otherwise, Applicants decline to subscribe to any statement or characterization in the Office Action.


If the Examiner believes a telephone conversation might advance prosecution, the Examiner is invited to call Applicants' undersigned attorney at 202-408-4387.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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